

**PHILIPS**

9

**U. S. Philips Corporation**

Intellectual Property Department

Via Facsimile  
Number (703) 308-6916  
with Confirmation by Mail

November 22, 1996

United States Patent & Trademark Office  
Box Comments-Patents  
Assistant Commissioner for Patents  
Washington, DC 20231  
Attention: Jeffrey V. Nasc

**FAX RECEIVED**  
NOV 22 1996  
**PATENT OFFICE**  
Patent Office

Re: **PTO Proposal Making Miscellaneous Amendments to  
Patent Rules of Practice  
RIN 0651-AA80  
Docket 960606 163-6163-01**

We have studied the proposed rule changes as they appear in 60 FR 49820. Overall, we believe that these proposed changes should be adopted and will prove to be salutary in their effect.

However, as a large user of the United States Patent & Trademark Office (843 United States Patent Applications filed in calendar year 1995, with a total of 2565 Patent Applications currently pending), we are concerned that certain of the proposed changes could have a potential adverse impact on our practice. Following are our specific comments and/or recommendations directed to these concerns.

**Section 1.116 Amendments after final action.**

Under the proposed amendment to §1.116, amendments after final rejection would be limited to cancelling claims and complying with any requirements of form and any amendment not in compliance must be submitted with a request under §1.53(b)(3) [for a continuing prosecution application (CPA)] to ensure its consideration. Further, the proposed amendment strikes the prior language in subdivision (a) that amendments placing claims in better form for consideration on appeal may be admitted and in subdivision (b) that an amendment when not otherwise proper may be admitted on a sufficient showing why it is necessary and was not earlier presented.

Jeffrey V. Nase  
November 22, 1996  
Page 2

The accompanying USPTO discussion states that the proposed elimination of first action final practice under §1.113(c) is the *quid pro quo* for the proposed strict limitation of after final amendment practice and that any comments objecting to this proposed limitation of after-final practice should be framed in the context of the linkage to the proposed elimination of first action final practice. The USPTO discussion also indicates that the proposed amendment would not eliminate the authority of the examiner to enter an after-final amendment that places the application in condition for allowance.

The PTO position that an amendment of its rules to improve service requires compensation, in the form of a *quid pro quo* from its customers, is arbitrary, capricious and contrary to principles of good government. The concept of an administrative agency of the U.S. government bargaining with itself on behalf of its constituency is ingenuine. We urge the office to drop this offensive position.

We support the elimination of the first action final practice and believe it is justified because the applicant should receive a full examination for a full filing fee. Hence, it need not be justified by a *quid pro quo* linkage to the after-final amendment practice. We believe that the proposed change of the after-final amendment practice should not be made because it will institutionalize the filing of a continuation in almost every case, thereby substantially increasing the fees to the applicant on average. If a *quid pro quo* is necessary, we believe the most that may be justified is retention of the proposed deletion in §1.116(b) providing 1.116(a) specifically indicates that the examiner may enter an amendment which presents claims in better form for appeal or which places the application in condition for allowance.

We believe that the mentioned *quid pro quo* has nothing to do with depriving the examiner of discretion to enter an after final amendment which places the claims in better form for consideration on appeal. In a case which is ripe for appeal, except for some minor aspects, there seems to be little value to requiring the applicant to pay an additional filing fee merely to place the claims in better form for appeal.

Notwithstanding the USPTO discussion to the contrary, the requirement of filing a request for a CPA when the after final amendment places the application in condition for allowance, but is not limited to cancelling claims or complying with any requirement of form, appears on its face to preclude the examiner from entering the after final amendment without charging the additional filing fee for the CPA.

In general, no reason is seen for striking the language allowing the examiner to consider the after-final amendment, since such language is not written in mandatory terms.

Jeffrey V. Nasc  
November 22, 1996  
Page 3

### **Section 1.121 Manner of making amendments.**

The proposed changes to this section would require that amendments to a claim (other than cancellation) be made by rewriting the entire claim, and that each time a claim is rewritten, a separate complete copy of all the claims be submitted (see, eg., 1.121(a)(2)(ii)). Changes to the specification (other than deletions) could only be made by submitting a copy of the rewritten material. All changes would be indicated by brackets and underlining. Line-by-line instructions to insert and delete matter would no longer be permitted.

If these changes were to be adopted, they would require a significant increase in the time to prepare amendments, especially amendments requiring only minor changes to the specification or claims, since line-by-line instructions would no longer be permitted, and since each new amendment to the claims, even a minor amendment, would require the generation of a whole new set of claims.

We feel that the burden of these proposed changes to section 1.121 could be lessened if the PTO would permit the indication of amendments by "red-lining symbols" other than underlining and brackets, eg, highlights and strike-throughs, which are available on the standard versions of commonly used word processing programs such as Word and Word Perfect. Thus, for example, when the specification and claims are generated using one of these programs, changes could be made by copying the document to a new file, editing the document in the new file, and then using the Compare Document or other similar feature of the program, to add markings to the new document to show which changes have been made. The relevant portions of the new document, both with and without markings, would then be provided to the PTO in accordance with the proposed rule changes.

Although special programs are available which include the option of showing changes with brackets and underlining, such as Compare Rite, we feel that the added expense of acquiring these programs could be avoided by the simple expedient of permitting changes to be indicated with symbols other than brackets and underlines.

### **Section 1.115 Amendment.**

We also believe that the proposed subsection 1.115(f) is inconsistent with the proposed changes to 1.121. Specifically, subsection 1.115(f) requires that "To amend a clause that was previously amended, the clause should be wholly rewritten so that no interlineations or deletions shall appear in the clause as finally presented". However, subsection 1.121(a)(1)(iv), for example, requires "Underlining below the subject matter added and brackets around the subject matter deleted". We believe that clarification is required to reconcile this apparent inconsistency.

7  
nub  
w. 10

Jeffrey V. Nase  
November 22, 1996  
Page 4

**Section 1.53 Application number, filing date, and completion of application.**

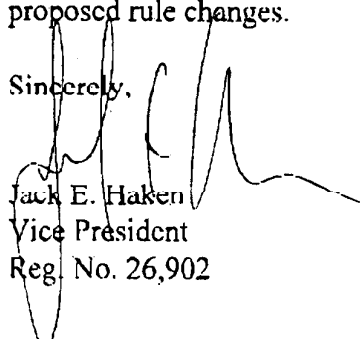
2 We would like to have additional language added to subsection 1.53(b)(1)(iii) to permit execution of copies of the oath or declaration by less than all of the inventors, without cross-reference to the other copies, to facilitate contemporaneous executions by geographically separated inventors.

**Section 1.182 Questions not specifically provided for.**

The proposed change to this section would eliminate the requirement for a written decision on certain petitions. We believe that a written decision is necessary to an applicant's understanding of the basis for the decision, and to preserve a proper record for appeal. *intent is to make b. t. instruction*

We appreciate the opportunity afforded by the PTO to offer the above comments on the proposed rule changes.

Sincerely,

  
Jack E. Haken  
Vice President  
Reg. No. 26,902